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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,188	01/29/2002	Philip G. Costello	BG-13201	.3935

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EXAMINER

KRAMER, DEVON C

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,188

Applicant(s)

COSTELLO ET AL.

Examiner

Devon C Kramer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 8, 10-26 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-7, 9, 27-31 and 35-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

- 1) Claim 27 is objected to because of the following informalities:

Claim 27 lines 15 and 18, "the counterbalance" should be --the counterbalance assembly--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 1-2, 5-7, 9, 27-31, and 35-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said vehicle body" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitation "said vehicle body" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 27 and 43 recite the limitation "said body" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 41 recites the limitation "said vehicle body" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 43 recites the limitation "said vehicle body" in line 5. There is insufficient antecedent basis for this limitation in the claim.

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Claims 35-36 recite the limitation "said vehicle body" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 1-2, 5-7, 9, 27-31, and 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuspert et al (5810339) in view of Besonen et al (5307753) and further in view of Kimura et al (4629167)

In reference to claims 1, 27, and 35-44, Kuspert et al teaches the use of a counterbalance comprising a protective housing (22, 23) having a first end / tube (22) attached to a tailgate (12) and a second end / tube (23) attached to the vehicle body (10); wherein when the counterbalance is in a fully extended position, the protective housing is oriented at an angle between the tailgate and the vehicle body (figure 1) and wherein the counterbalance is in the fully retracted position, the protective housing is oriented in a vertical position with respect to the vehicle body and the tailgate (please note that this is inherent from figure 1) . Kuspert lacks the specific counterbalance claimed.

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Besonen et al provides a counterbalance capable of use on a tailgate of a motor vehicle, the counterbalance at least partially controls a load applied to the counterbalance comprising: an elastic element (30) that at least partially counters the load; a flexible extension limiter (25) that provides a stop which defines a fully extended position of the counterbalance and which counters loads applied to the counterbalance after the counterbalance is in the fully extended position. Besonen lacks the teaching of a second member of the housing having a projection forming a gap between first and second housing members.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the tailgate assembly of Kuspert with a counterbalance like that of Besonen to control the movement of the gate during opening and closing and to limit the extent to which the tailgate can be opened, thus protecting the hinges of the tailgate and increasing the life of the spring in the interior of the counterbalance due to fatigue.

Kimura et al teaches a projection that forms a gap between first and second housing members (see figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the assembly of Kuspert as modified by Besonen with a projection forming a gap between first and second housing portions taught by Kimura et al merely to reduce friction between the two housing parts and to allow escape and entrance of air to prevent the device from becoming locked.

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In reference to claims 2 and 28, Besonen et al provides a counterbalance where the elastic element is a spring.

In reference to claims 5-6 and 29-30, Besonen et al provides a counterbalance where the flexible extension limiter is a material strap.

In reference to claims 7, 9 and 31, Besonen et al provides a counterbalance including a protective housing that at least partially covers the elastic member and the flexible extension limiter.

Response to Arguments

6) Applicant's arguments with respect to claims 1-2, 5-7, 9, 27-31 and 35-44 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks state that applicant incorporated the allowable subject matter into the independent claims. For example, claim 41 is referred to in the remarks as being placed in condition for allowance, but the limitations of claim 7 are not included in the amended claim 41. Please note that to rewrite a claim that is considered allowable if rewritten in independent form, all of the limitations of the claims from which that claim depends must be incorporated into the amended claim.

Conclusion

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Perlini and Pileggi teach projections forming gaps between first and second housing members.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 571-272-7118. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devon C Kramer
Examiner
Art Unit 3683

DK

DEVON C. KRAMER
PATENT EXAMINER

Devon C. Kramer
5/10/07